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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,597	09/20/1999	DAVID C. CARRITHERS	MRZ-8980	2447

7590 10/03/2003

SENNIGER POWERS LEAVITT & ROEDEL  
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ST. LOUIS, MO 63102

EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/399,597	CARRITHERS ET AL.
	Examiner	Art Unit
	Arthur Duran	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 May 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) 1-28 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-28 have been examined.

### ***Response to Amendment***

2. The Amendment filed on 9/19/02 is sufficient to overcome the Akel, Lalonde, and Ray reference.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-28 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-28 of U.S. Patent No. 5,956,695. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the current Application and of the Patent are identical except for removing from the current Application the features involving checking for a sufficient balance in the participant's account to cover the transaction. It would be obvious to remove this feature from the current Application because the participant's balance is not critical to the filtering process of validating whether the merchant and participants are both authorized parties in the program. In items no. 9

and 12 of the Prosecution history (Application 08,969,093) for the Patent 5,956,695, the Applicant stated that the uniqueness of the claims is the filtering process involving the proper authorizations of the parties involved. The Applicant would be motivated to remove this balance checking feature in order to broaden the applicability of the claims.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-28 have been considered and were found persuasive. Therefore, the previous grounds of rejection is withdrawn.

As stated in the Interview Summary of May 2, 2003, a new action has been issued.

***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter. Present Application 09/399,597 is a continuation off of now US Patent No. 5,956,695. Claims 1-28 the present Application and the Patent are identical except for removing from the current Application the features involving checking for a sufficient balance in the participant's account to cover the transaction. The Prosecution History for US Patent No. 5,956,695 was referenced by the Examiner and a determination made that the participant's balance is not critical to the filtering process of validating whether the merchant and participants are both authorized parties in the program. In items no. 9 and 12 of the Prosecution history (Application 08,969,093) for the US Patent No. 5,956,695, the Applicant stated that the uniqueness of the claims is the filtering process involving the proper authorizations of the parties involved.

On page 6 of Item 9 of the Prosecution history (Application 08,969,093) for the Patent 5,956,695, Applicant states, "In other words, each of the independent claims recite a filter or filter processor (hereinafter "filter") in combination with a program such that only a selected, authorized group of merchants of the program are permitted to accept the cards." On page 7 Applicant states, "Existing systems have 2 classes of merchants: 1) participating merchants which are part of the credit/debit network, and 2) nonparticipating merchants which are not part of the credit/debit network. In contrast, the system of the invention has three class of merchants: 1) authorized, participating merchants which are part of the program 2) unauthorized, participating merchants which are not part of the program, and 3) nonparticipating merchants." The prior art recognizes the distinction between participating merchants and nonparticipating merchants but fails to recognize the distinction of the invention between authorized participating merchants and unauthorized participating merchants of the program.

The present application has a priority date via continuation to March 21, 1996 and continuation-in-part to March 21, 1995. No US patents, US patent Applications, European patents, or Japanese patents were found with the features of the Applicant's independent claims and a priority date of earlier than March 21, 1996.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. McCarthy (5,117,335) discloses utilizing credit cards for multiple merchants;
- b. Kato (JP 04070992) discloses cards for multiple purposes such as credit and debit.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

JD  
9/9/03

  
James W. MYHRLE  
Primary Examiner  
Art Unit 3622